

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Applicants: Bednorz et al.

Serial No.: 08/303,561

Filed: September 9, 1994

Date: July 29, 2003

Group Art Unit: 1751

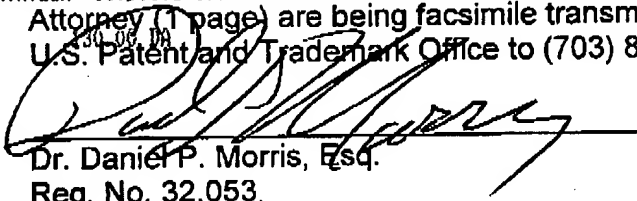
Examiner: M. Kopec

Docket No: YO987-074BY

For: NEW SUPERCONDUCTIVE COMPOUNDS HAVING HIGH TRANSITION
TEMPERATURES, AND METHODS FOR THEIR USE AND PREPARATIONCommissioner for Patents
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I hereby certify that this paper (3 pages) and Appointment of Associate Power of Attorney (1 page) are being facsimile transmitted under Rule 37 CFR 1.61(d) to the U.S. Patent and Trademark Office to (703) 872-9600 on July 29, 2003.



Dr. Daniel P. Morris, Esq.
Reg. No. 32,053.

PETITION TO SUSPEND ACTION
UNDER 37 CFR 1.103 DATED 08/04/2000

On August 4, 2000 applicants petitioned for suspension of action in copending US Application Serial Number 08/479,810 (Divisional Application) which is a division of the above identified application until a decision was rendered by the Board of Patent Appeals and Interferences in the present application. The petition to suspend was granted in paper 29 dated October 6, 2000 of the Divisional Application. Applicants requested the suspension since the issues presented in the appeal of the present application were essentially identical to the grounds for rejection in the Divisional Application. Applicants, therefore, felt that suspension of action in the Divisional Application was appropriate until there was a decision by the Board of Appeals and Interferences in the present application since suspension would potentially avoid unnecessary prosecution of the Divisional Application.

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Certain factual information (Additional Essential Information) that is primarily in the public domain that applicants believe is essential to their arguments in overcoming certain rejections of claims, which has been either entered in the Divisional Application or submitted with the response accompanying the Petition to Suspend Action thereon has not been entered in the present application. Some of this Additional Essential Information was obtained by applicants after the final rejection in the present application and some of this Additional Essential Information was obtained after the appeal brief was filed in the present application. Applicants submitted all of this Additional Essential Information in the present application by amendment after final rejection and with the appeal and reply briefs herein. Since applicants arguments in the appeal and reply briefs of the present application relied on this Additional Essential Information and since the status of entry by the Examiner in the present application was unclear, the Board of Patent Appeals and Interferences remanded the appeal of the present application back to the Examiner to clarify entry of this Additional Essential Information. Because this Additional Essential Information was submitted in the present application after final rejection, the Examiner procedurally cannot enter this Additional Essential Information herein.

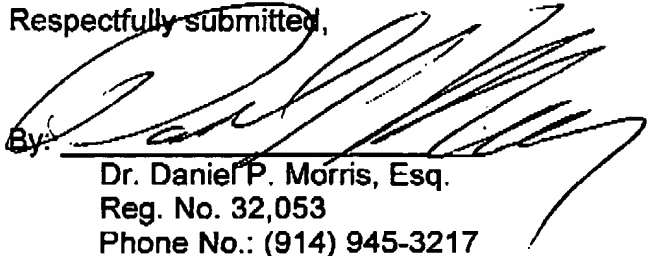
All of the Additional Essential Information submitted in the present application can be entered in the Divisional Application since it is not under final rejection. Therefore, applicants believe that it would not be an effective use of the USPTO's time, in particular the Examiner's time and the Board of the Appeals and Interferences' time to go forward with the appeal in the present application without all the Additional Essential Information since the same issues will be before the Examiner and possibly the Board again in the Divisional Application with all of the Additional Essential Information entered and considered. If the present application is not suspended, the Board of Appeals and Interferences could, in the absence of all the Additional Essential Information, render a decision inconsistent with the decision of the Examiner in the Divisional Application or by the Board in an appeal to the Board of Patent Appeals and Interferences in the Divisional Application which will have entered therein all of the Additional Essential Information.

Thus, applicants are submitting a Petition to Suspend Action Under 37 CFR 1.103 in the present application for six months or until prosecution in the Divisional Application is closed on the merits for the reasons given herein and applicants concurrently herewith are submitting a request that the suspension of action in the Divisional Application be withdrawn. This will potentially avoid an unnecessary decision by the Board of Appeals and Interferences in the appeal of the present application since all the issues may be resolved in the Divisional Application or the issues may be substantially simplified for appeal in the Divisional Application with all of the Additional Essential Information considered.

Suspension of action in the present application so that the prosecution of the Divisional Application can go forward with all of the Additional Essential Information considered and of record will either result in allowance of the claims therein or if applicants choose to appeal any unallowed claims, that appeal will present to the Board of Patent Appeal and Interferences a complete factual record upon which to render a decision. Whereas if the present application is not suspended the Board will be presented for decision a record lacking very relevant information that is in the public domain.

Please charge any fee necessary to enter this paper and any previous paper to deposit account 09-0468.

Respectfully submitted,

By: 
Dr. Daniel P. Morris, Esq.
Reg. No. 32,053
Phone No.: (914) 945-3217

IBM Corporation
Intellectual Property Law Dept.
P. O. Box 218
Yorktown Heights, New York 10598